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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,125	05/22/2001	Elizabeth S. Light	112/002/CON1	9583

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VENTANA MEDICAL SYSTEMS, INC.
ATTENTION: LEGAL DEPARTMENT
1910 INNOVATION PARK DRIVE
TUCSON, AZ 85755

EXAMINER

SISSON, BRADLEY L

ART UNIT PAPER NUMBER

1634

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,125

Applicant(s)

LIGHT, ELIZABETH S.

Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/15/05 & 8/23/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The specification is objected to as documents have been improperly incorporated by reference. In particular, the specification states at page 20:

All references mentioned above are incorporated in their entirety by reference.

Such omnibus language fails to specify what specific information applicant seeks to incorporate by reference and similarly fails to teach with detailed particularity just where that specific information is to be found in each of the cited documents.

Attention is also directed to MPEP 608.01(p)I, which, in pertinent part, is reproduced below:

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. (Emphasis added)

As set forth In *Ex parte* Raible, 8 USPQ2d 1707, (BPAI, 1998)

The examiner is of the opinion that the general incorporation by reference of the Bentley disclosure in appellant's specification is insufficient to support the specific disputed limitations of the present claims in the manner required by section 112 of the statute. We agree

* * *

We believe that the doctrine of incorporation by reference is of no avail to appellant in this regard since there is no specific indication in the instant specification of the particular features disclosed by Bentley which correspond to those intended for use in the here-claimed device; nor does the specification identify the specific portions of the patent which appellant may have intended to rely upon to supplement his disclosure. The purpose of incorporation by reference in an application of matter elsewhere written down is for economy, amplification, or clarity of exposition, by means of an incorporating

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statement clearly identifying the subject matter which is incorporated and where it is to be found. In re de Seversky , 474 F.2d 671, 177 USPQ 144 , (CCPA 1973).

Accordingly, the cited documents are not considered to have been properly incorporated by reference and as such, have not been considered with any effect towards their fulfilling, either in part or in whole, the enablement, written description, or best mode requirements of 35 USC 112, first paragraph.

Claim Objections

2. Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As presently worded, the method of claim 27 requires that one use digoxigenin-labeled probes. In accordance with claim 28, however, such a requirement is waived in that the probe can be labeled with some other label. The aspect of opening up claim 27 to where alternative labels can be used in an alternative manner is considered to broaden, not further limit the method of claim 27, from which said claim 28 depends.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the

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specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As presently worded, one is to use digoxigenin-labeled probes, anti-digoxigenin antibodies and bright field microscopy to detect hybridization products. In accordance with claim 28, however, no digoxigenin-labeled probe is used. Rather, one is to use either biotinylated probes or fluorescein-labeled probes. The specification has not been found to set forth a reproducible procedure whereby anti-digoxigenin antibodies are able to detect biotin or fluorescein. Further, the specification has not been found to set forth a reproducible procedure whereby brightfield microscopy is used to detect fluorescein, which is generally detected via fluorescence microscopy. The situation at hand is analogous to that in *Genentech v. Novo Nordisk A/S* 42 USPQ2d 1001. As set forth in the decision of the Court:

“‘[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.’ *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *see also Amgen Inc. v. Chugai Pharms. Co.*, 927 F. 2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed Cir. 1991); *In re Fisher*, 427 F. 2d 833, 166 USPQ 18, 24 (CCPA 1970) (‘[T]he scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.’). ”

“Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. *See Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966) (starting, in context of the utility requirement, that ‘a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.’) Tossing out the mere germ of an idea does not constitute enabling disclosure. While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention.

“It is true . . . that a specification need not disclose what is well known in the art. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385,

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231 USPQ 81, 94 (Fed. Cir. 1986). However, that general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the specification, not the knowledge of one skill in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. This specification provides only a starting point, a direction for further research. (Emphasis added)

In view of the breadth of scope claimed, the limited guidance provided, the unpredictable nature of the art to which the claimed invention is directed, and in the absence of convincing evidence to the contrary, the claims are deemed to be non-enabled by the disclosure. For the above reasons, and in the absence of convincing evidence to the contrary, claims 27 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,565,323 (Parker et al.) in view of Gelmetti et al., and US Patent 4,935,341 (Bargmann et al.).
7. Parker et al., column 8, bridging to column 9, teaches of numerous means and methodologies for detecting nucleic acids. As seen in column 8, lines 25-32, digoxigenin-labeled probes are detected by use of anti-digoxigenin antibodies. As disclosed therein, the complex can be detected through the use of enzymes. Phosphatase and peroxidase are explicitly disclosed. Also disclosed is the alternative use of fluorophores such as fluorescein (column 8, line 40) and biotin (column 8, line 27).
8. A review of Parker et al., fails to locate where *in situ* hybridization is disclosed. Also, Parker et al., has not been found to disclose the detection of Her-2/neu gene, or the use of brightfield microscopy.
9. Gelmetti et al., each at length the use of digoxigenin-labeled probes for the detection of nucleic acids via *in situ* hybridization. Gelmetti et al., page 223, Fig. 2, provides a brightfield photomicrograph of *in situ* hybridization.
10. Gelmetti et al., have not been found to teach the detection of Her-2/neu gene.
11. Bargmann et al., discloses probes and methods of using same whereby neu oncogenes are detected in cells (abstract). Bargmann et al., columns 5-7, disclose the identification of normal and transforming variants of HER-2/neu via nucleic acid hybridization assays.
12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Parker et al., with that of Gelmetti et al., and

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Bargmann et al., so as to detect HER-2/neu genes via *in situ* hybridization as both Parker et al., and Gelmetti et al., teach of using the same type of probes. In view of the intense interest in HER-2/neu, as disclosed by Bargmann et al., and the admitted common placement of brightfield microscopes in laboratories generally,¹ aid ordinary artisan would have been amply motivated and would have had a most reasonable expectation of success given the well-developed state of the art.

13. For the above reasons, and in the absence of convincing evidence to the contrary, claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,565,323 (Parker et al.) in view of Gelmetti et al., and US Patent 4,935,341 (Bargmann et al.).

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

¹ Applicant's representative, in traversing the prior art-based rejection of claims, asserts at page 6 of their response (page 15/20 of their facsimile transmission) that light microscopes are found in labs generally and are used to perform brightfield microscopy.

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751.

The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bradley L. Sisson
Primary Examiner
Art Unit 1634

BLS
14 September 2005